Decision for dispute CAC-ADREU-001760

Case number	**CAC-ADREU-001760**
Time of filing	**2006-06-12 11:42:08**
Domain names	**nen.eu**

Case administrator

Name	**Eva Zahořová**

Complainant

Organization / Name	**Stichting Nederlands Normalisatie-Instituut, Peter den Hartog**

Respondent

Organization / Name	**EURid**

OTHER LEGAL PROCEEDINGS

The Panel is not aware of other legal proceedings which are pending or decided and which relate to the disputed Domain Name.

FACTUAL BACKGROUND

This decision arises from a complaint filed by the Dutch foundation Stichting Nederlands Normalisatie-Instituut ("the Complainant"), against the decision by EURid ("the Respondent"), to register the domain name nen.eu (“the disputed Domain Name”) to a third party, Citadel 01 B.V. ("Citadel 01").

On 07 December 2005 at 11:00:50 am, Citadel 01 applied for the disputed Domain Name under the first part of the phased registration period. The mark on which Citadel 01 relied was the Benelux trade mark registration No. 777 073 "N=&" (word), registered on 10 November 2005. Documentary evidence of the registered trademark was submitted by the Complainant in due time. According to the registration excerpt, the owner of the Benelux mark was a company called "Citadel 01 B.V.".

The Respondent accepted the application on the basis that the right of Citadel 01 to the name had been proven.

On 07 December 2005 at 11:22:17 am, the Complainant also applied for the disputed Domain Name under the provisions of the first part of the phased registration period. The Complainant is now the next applicant in the queue for the disputed Domain Name (position two).

On 08 June 2006, the Complainant filed a complaint with the Czech Arbitration Court, asking to cancel the decision of the Respondent in accepting the application for the disputed domain name filed by Citadel 01 and to attribute the disputed Domain name to the Complainant.

On 12 June 2006, the Czech Arbitration Court informed the Respondent about the complaint and requested it to disclose information and documentary evidence related to the disputed Domain Name. On 19 June 2006, the Respondent provided the requested information and evidence.

On 23 June 2006, the ADR proceedings commenced.

On 10 August 2006, the Respondent submitted its response with the Czech Arbitration Court.

On 15 August 2006, the Czech Arbitration Court appointed Mr. André Pohlmann as sole Panelist in this matter.

On 22 August 2006, the Panel sent a non-standard communication to both parties inviting them to submit observations as to whether the Benelux trade mark "N=&" invoked by Citadel 01 as basis for the registration of the disputed Domain name meets the criteria for the registration of the Domain name. The Panel requested both parties to submit their observations by Monday, 04 September 2006.

The Complainant submitted a non-standard communication in reply to the Panel's request on 01 September 2006. The Respondent sent a non-standard communication on 04 September 2006.

The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence in compliance with Paragraph B5 of the ADR Rules and Paragraph B(5) of the Supplemental ADR Rules.

A. COMPLAINANT

In support of its position Complainant contends as follows:

1. The Respondent's database mentions A. Verlinden as the individual representing Citadel 01. According to the trade register of the Dutch Chamber of Commerce, Mr. Barend Hohmann is mentioned as director and sole and independent shareholder of Citadel 01. Consequently, only Mr. Barend Hohmann or someone having a power of attorney on his behalf could be able to legally represent and bind Citadel 01. The name A. Verlinden is a fictive name and used as an alias by Mr. Hohmann in order to protect himself against complaints from third parties. The application on behalf of Citadel 01 for the disputed Domain Name has not been filed in accordance with Article 3 of EC Regulation No. 874/2004.

2. As regards the question whether Benelux trademark No. 777 073 “N=&” meets the criteria for the registration of the disputed Domain Name, the Complainant takes the view that the prior Benelux mark could not form the basis for the disputed Domain Name. Citadel 01, the owner of the trademark “N=&”, does not have rights to the word “NEN”, as the trademark consists of three characters, namely one letter ("N") and two special characters ("=" and "&"). The requested Domain Name must consist of the complete name for which the Prior Right exists (cf. Article 10(2) EC Regulation No. 874/2004). The validation agents should assess the right which is claimed as basis for the requested domain name. As confirmed in prior decisions (e.g. case No. 394 [FRANKFURT]), the word "assess" implies at least some degree of judgment by the Respondent or the validation agents, who are subcontractors of the Respondent, and not the automatic acceptance of the substitution of the symbols mentioned in Article 11 of EC Regulation No. 874/2004 for any of the three options mentioned therein at the choice of the applicant. In the present case, such degree of judgment should have been exercised and the application for the Domain name “nen.eu” based on the trademark “N=&” should have been rejected. Article 11 of EC Regulation No. 874/2004 is a technical provision and the priority of the three options included therein should be assessed by comparing the Domain name applied for and the Prior Right on which it is based. In the present case, by transcribing the “&” into “EN” (Dutch for “AND”) and omitting the “=” symbol, the Respondent would grant rights to Citadel 01 in a Domain name for which it does not have prior rights according to Article 10(1) of EC Regulation No. 874/2004. At least, the “=” should also have been transcribed into, for example, “IS”, “EQUAL”, “IST”, “GLEICH”, “EST”, “EGAL”, or replaced by a hyphen. The Respondent failed to exercise a proper assessment of the disputed Domain Name and the prior right. The disputed Domain Name does not correspond to the prior right in accordance with Articles 10 and 11 of EC Regulation No. 874/2004.

3. In conclusion, the Complainant requests the annulment of the Respondent's decision to accept the application for the disputed Domain Name filed on behalf of Citadel 01, and to subsequently attribute the disputed Domain Name to the Complainant.

B. RESPONDENT

The Respondent makes the following observations:

1. The name "Citadel 01 B.V." was provided as the name of the organisation. Accordingly, Citadel 01 was considered as the applicant. Article 14(7) of EC Regulation No. 874/2004 provides that under the phased registration the Respondent shall register the domain name if it finds that the applicant has demonstrated a prior right. Therefore, during the phased registration period, the decision by the Respondent to register the domain name can only be based on whether or not the applicant demonstrated a prior right on the name applied for. Citadel 01 demonstrated that it was the holder of a prior right in the sign "N=&". Consequently, the Respondent had no choice but to validate the application. The Regulation does not empower the Registry to validate that the physical person which introduced the documents in the name of an organisation has been empowered to do so. As long as the name of the applicant (i.e. Citadel 01) was the name of the holder of a prior right on the name, the Respondent had to validate the application. As there is no obligation under the Regulation for the Respondent to control any other name than the one of the applicant, the Complaint must be dismissed on this point.

2. The decision to grant the disputed Domain Name on the basis of the Benelux trade mark "N=&" is in compliance with Articles 10 and 11 of EC Regulation No. 874/2004. Article 11 of the Regulation states that where the name for which prior rights are claimed contains special characters, such as an ampersand or the equal sign, these shall be eliminated entirely from the corresponding domain name, replaced with hyphens, or, if possible, rewritten. These three options are provided to the applicant. In the case at hand, the applicant exercised two of the choices the Regulation offered him. On the one hand, he chose to eliminate the equal sign (“=”) of the trademark sign and, on the other side, he chose to rewrite the ampersand (rather than eliminate it or replace it with a hyphen) using the word "EN" which in Dutch language means "AND" and it is thus a correct way to rewrite an ampersand. Indeed, Dutch is one of the official languages of the European Union. There is no rule which limits an applicant to rewrite the special character in a particular language. To that regard, the Respondent would like to note that the rationale for the .eu tld is to promote the European identity on the internet.

3. The Respondents requests to dismiss the Complaint.

DISCUSSION AND FINDINGS

The Complainant’s application is made pursuant to Article 22(1)(b) of EC Regulation No. 874/2004, which provides that an ADR procedure may be initiated by any party where a decision taken by the Registry conflicts with this Regulation or with EC Regulation No. 733/2002. Pursuant to Article 22(11) second subparagraph of EC Regulation 874/2004, the sole purpose of these proceedings is accordingly to determine whether the decision taken by the Respondent was in accordance with EC Regulation No. 874/2004 or with EC Regulation No. 733/2002.

1. The validity of the request submitted by Citadel 01

According to Article 3 of EC Regulation No. 874/2004, the request for domain name registration shall include all of the following:

"(a) the name and address of the requesting party;

(b) a confirmation by electronic means from the requesting party that it satisfies the general eligibility criteria set out in Article 4(2)(b) of Regulation (EC) No 733/2002;

(c) an affirmation by electronic means from the requesting party that to its knowledge the request for domain name registration is made in good faith and does not infringe any rights of a third party;

(d) an undertaking by electronic means from the requesting party that it shall abide by all the terms and conditions for registration, including the policy on the extra-judicial settlement of conflicts set out in Chapter VI.

Any material inaccuracy in the elements set out in points (a) to (d) shall constitute a breach of the terms of registration."

In the case at hand, the request for the disputed Domain Name was made on behalf of Citadel 01. Thus, the copy of the request provided by the Respondent states under the point "Naam van de Aanvrager ("Aanvrager"): Citadel 01 B.V." ("name of the applicant: Citadel 01 B.V."). There is no indication that the person signing the request was not authorised to do so on behalf of Citadel 01. The Complainant itself emphasised that the person "behind" the allegedly fictitious name "A. Verlinden" mentioned in the request was Mr. Barend Hohmann, the director of Citadel 01. Consequently, Mr. Hohmann was authorised to sign the request on behalf of Citadel 01 even if he did not reveal his name in the application form. The request therefore complies with Article 3 of EC Regulation No. 874/2004.

2. The prior right invoked by Citadel 01

The issue of whether or not the prior Benelux trade mark "N=&" constitutes a valid basis for the registration of the disputed Domain Name under the phased registration was not raised by the parties but by the Panel itself. The Panel submitted a non-standard communication to the parties in accordance with Rule B8 of the ADR Rules. According to Rule B7 of the ADR Rules, the Panel shall conduct the ADR Proceedings in such a manner as it considers appropriate in accordance with the Procedural Rules. The Panel is not obliged, but is permitted in its sole discretion, to conduct its own investigations on the circumstances of the case. The Panel considers that there is nothing in the Procedural Rules prohibiting the Panel from deciding an ADR Proceeding based also on arguments and findings which had not been submitted by the Parties.

The relevant provisions of EC Regulation No. 874/2004 which require particular consideration are the following:

Article 10(2): "The registration on the basis of a prior right shall consist of the registration of the complete name for which the prior right exists, as written in the documentation which proves that such a right exists."

Article 11: […] "Where the name for which prior rights are claimed contains special characters, spaces, or punctuations, these shall be eliminated entirely from the corresponding domain name, replaced with hyphens, or, if possible, rewritten.

Special character and punctuations as referred to in the second paragraph shall include the following:

~ @ # $ % ^ & * ( ) + = < > { } [ ] | \ /:; ',. ?

[...]"

Article 14 seventh paragraph: "The relevant validation agent shall examine whether the applicant that is first in line to be assessed for a domain name and that has submitted the documentary evidence before the deadline has prior rights on the name. If the documentary evidence has not been received in time or if the validation agent finds that the documentary evidence does not substantiate a prior right, he shall notify the Registry of this."

As stated in Article 14 of EC Regulation No. 874/2004, it is the obligation of the validation agent to examine whether "the applicant that is first in line to be assessed for a domain name" has prior rights on the claimed name. Article 14 seventh paragraph indicates that the validation agent has to exercise a certain degree of judgment when "assessing" and "examining" the prior right. This is also confirmed by Recital 12 of Regulation No. 874/2004 which states that the validation agents should assess the right which is claimed for the domain name on the basis of the evidence provided by the applicant. When comparing the prior right and the applied domain name, the validation agent has to evaluate whether the domain name is covered by the scope of protection of the prior right (see Decision No. 394 of 02 June 2006 [FRANKFURT]). The Panel takes the view that such an assessment should have been exercised by the validation agents and that the disputed Domain Name should not have been accepted on the basis of the prior Benelux trade mark "N=&".

It is clear from Article 10(2) of EC Regulation No. 874/2004 that only the holders of prior identical rights shall be eligible to apply for a domain name during the phased registration. Article 11 of EC Regulation No. 874/2004 contains the following three exceptions from the general rule of identity between the prior right and the requested domain name:

- Signs containing a space between the word elements of a prior right may be written with a hyphen between the word

elements or combined in one word (Article 11 first paragraph).
- Special characters may be eliminated, replaced with hyphens, or, if possible, rewritten under the conditions of Article 11 second paragraph.
- Finally, letters which cannot be reproduced in ASCII code may be reproduced without the additional elements of the letters or replaced by conventionally accepted spellings if the requirements of Article 11 fourth paragraph are met.

Being an exception to the general rule of identity, Article 11 has to be interpreted in a restrictive manner. Variations from the prior right can only be accepted if the result of the modification is still covered by the scope of protection of the prior right. The Panel takes the view that the scope of protection of the prior Benelux trade mark "N=&" does not cover the sign "NEN". The relevant public for the assessment of the scope of protection of the prior sign is the public of the territory where the earlier sign is protected (here: the Benelux). The consumers in the Benelux would not refer to "NEN" when being confronted with the sign "N=&". They may refer to "N is en" or "N est et" (meaning "N is and" in English) but not to "NEN". Since the relevant public would not be in a position to associate the disputed Domain Name ("NEN") with the prior Benelux trade mark ("N=&"), the scope of protection of the latter does not include the disputed Domain Name.

Consequently, Citadel 01 was not eligible to apply for the disputed Domain Name during the first part of the phased registration on the basis of the claimed prior Benelux trade mark. The decision of the Respondent to accept the application was in conflict with Article 10(2) and Article 11 of EC Regulation No. 874/2004.

FOR ALL THE REASONS STATED ABOVE, THE COMPLAINT IS

For the reasons given above, and in accordance with Article 22(11) second subparagraph of EC Regulation No. 874/2004 and Paragraph B11(c) of the ADR Rules, the Panel decides that

- the decision of the Respondent to allow the application for the domain name nen.eu filed by Citadel 01 B.V. shall be annulled, and
- the domain name nen.eu be attributed to the Complainant – being the next applicant in line for the registration of the disputed Domain Name - subject to its compliance with the general eligibility criteria set out in EC Regulation No. 874/2004 and in EC Regulation No. 733/2002.

PANELISTS

Name	**André Pohlmann**

DATE OF PANEL DECISION 2006-08-21

Summary

ENGLISH SUMMARY OF THIS DECISION IS HEREBY ATTACHED AS ANNEX 1

This case concerns the question whether the Benelux trade mark "N=&" meets the criteria for the registration of the domain name "NEN". The Panel takes the view that the Respondent should not have accepted any of the three options for replacing or eliminating special characters at the free choice of the party requesting the domain name. Article 11 of EC Regulation No. 874/2004 rather requires the validation agents to exercise a certain degree of judgment when comparing the claimed prior right with the applied domain name. This assessment has also to take into account whether the scope of protection of the claimed prior right covers the requested domain name.